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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,762	08/06/2003	David S. Abdallah	PRIV-003/01US 307640-2004	1715
22903 7590 07/11/2007 COOLEY GODWARD KRONISH LLP ATTN: PATENT GROUP Suite 500 1200 - 19th Street, NW WASHINGTON, DC 20036-2402			EXAMINER GERGISO, TECHANE	
			ART UNIT 2137	PAPER NUMBER
			MAIL DATE 07/11/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/635,762

**Applicant(s)**

ABDALLAH ET AL.

**Examiner**

Techane J. Gergiso

**Art Unit**

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04/24/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/24/2007</u> .  | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 2137

### **DETAILED ACTION**

1. This is a non-Final Office Action in response to the applicant's communication filed on April 24, 2007.
2. Applicant's election without traverse of new claims 15-37 in the reply filed on April 24, 2007 is acknowledged.
3. Claims 1-14 have been canceled without traverse and new claims 15-37 have been added. Claims 15-37 are pending.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 15-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Russo et al.

(hereinafter referred to as Russo; US Pub. No.: 2003/0115475)

As per claim 15:

Russo discloses a method, comprising:

receiving at a personal identification device a public key (0006; 0014; 0038);

Art Unit: 2137

sending an identifier from the personal identification device to a party based on the public key, the identifier being uniquely associated with the personal identification device (0006; 0048; 0024); and  
receiving at the personal identification device a digital certificate from the party based on the identifier, the personal identification device configured to enroll biometric data after the receiving the public key and after the receiving the digital certificate (0027; 0038; 0048).

As per claim 16:

Russo discloses a method, further comprising sending the public key from the personal identification device to the party after the receiving the public key (0021; 0025; 0038; 0080).

As per claim 17:

Russo discloses a method, wherein the receiving the digital certificate from the party is based on the public key and the identifier (0021; 0025; 0038; 0080).

As per claim 18:

Russo discloses a method, wherein the identifier is associated with an asymmetric key pair including a personal identification device public key and a personal identification device private key (0038; 0039).

As per claim 19:

Russo discloses a method, further comprising producing the identifier at the personal identification device (0043).

As per claim 20:

Russo discloses a method, further comprising receiving at the personal identification device the identifier from the party (0021; 0025; 0038; 0043; 0080).

As per claim 21:

Russo discloses a method, wherein the digital certificate includes the public key (0021; 0025; 0038; 0043; 0080).

As per claim 22:

Russo discloses a method, further comprising:  
disabling functionality within the personal identification device until biometric data associated with enrollment is received (figure 5: 119).

As per claim 23:

Russo discloses a method, comprising:  
sending a public key to a personal identification device (0006; 0048; 0024);  
receiving an identifier from the personal identification device, the identifier being uniquely associated with the personal identification device (0027; 0038; 0048);  
producing a digital certificate based on-the identifier (0027; 0038; 0048); and

Art Unit: 2137

sending the digital certificate to the personal identification device such that the personal identification device is configured to enroll biometric data after the receiving the digital certificate (0006; 0048; 0024).

As per claim 24:

Russo discloses a method, wherein the producing of the digital certificate is based, at least in part, on the public key (0021; 0025; 0038; 0080).

As per claim 25:

Russo discloses a method, wherein the receiving and the producing is performed by a first party, the method further comprising (0055):

receiving at the first party a digital certificate uniquely associated with a second party different from the first party (0055-0058);

adding a public key of the first party to the digital certificate associated with the second party (0055-0058); and

sending the digital certificate associated with the second party from the first party to the second party (0055-0058).

As per claim 26:

Russo discloses a method, wherein the digital certificate includes the public key (0021; 0025; 0038; 0080).

Art Unit: 2137

As per claim 27:

Russo discloses a method, further comprising producing at the party an asymmetric key pair uniquely associated with the party (0038; 0039).

As per claim 28:

Russo discloses a apparatus, comprising:

a memory configured to store biometric data of a user (0025; 0084);

a processor coupled to the memory and configured to produce a first identifier based on a public key associated with a first party, the first identifier being uniquely associated with the apparatus (0006; 0024; 0025;0048; 0084);

a biometric sensor coupled to the processor and configured to read biometric input from the user (0025;0040; 0065; 0084); and

a transmitter coupled to the processor and configured to transmit the first identifier to the first party and a second identifier to a second party different from the first party, the second identifier being uniquely associated with the biometric input (0055-0058).

As per claim 29:

Russo discloses an apparatus, wherein the biometric sensor is a fingerprint sensor configured to read a fingerprint from the user (0040; 0041; 0044).

As per claim 30:

Russo discloses an apparatus, wherein the transmitter is a transceiver configured to send information to and receive information from the first party (0055-0058).

As per claim 31:

Russo discloses an apparatus, further comprising a receiver configured to receive information from the first party (0055-0058).

As per claim 32:

Russo discloses an apparatus, wherein the transmitter is a radio frequency (RF) (0050)

As per claim 33:

Russo discloses an apparatus, further comprising a visual display coupled to the processor (0006; 0024; 0025; 0048; 0084).

As per claim 34:

Russo discloses a method, comprising:

receiving an encryption identifier at a personal identification device from a party (0027; 0038; 0048); and

receiving a digital signature at the personal identification device from the party, the encryption identifier and the digital signature collectively configured to enable verification of the personal identification device by the party, the personal identification device configured to enroll biometric data after the receiving the



encryption identifier and after the receiving the digital signature (0027; 0038; 0048; 0006; 0048; 0024).

As per claim 35:

Russo discloses a method, wherein: the encryption identifier is a public key (0027; 0038); and the receiving the digital signature including receiving a digital certificate including the digital signature (0027; 0038; 0048).

As per claim 36:

Russo discloses a method, wherein: the encryption identifier is a public key (0027; 0038); and the receiving the digital signature including receiving a digital certificate including the digital signature based on the public key (0027; 0038; 0048).

As per claim 37:

Russo discloses a method, further comprising: disabling functionality within the personal identification device until biometric data associated with enrollment is received (figure 5: 119).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

See the notice of reference cited in form PTO-892 for additional prior art

***Contact Information***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Techane J. Gergiso** whose telephone number is **(571) 272-3784** and fax number is **(571) 273-3784**. The examiner can normally be reached on 9:00am - 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Emmanuel Moise** can be reached on **(571) 272-3865**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*T-G*  
Techane Gergiso

Patent Examiner

Art Unit 2137

July 5, 2007

*Emmanuel Moise*  
EMMANUEL L. MOISE  
SUPERVISORY PATENT EXAMINER